

REMARKS

The pending claims are reproduced in clean, unmarked format for the examiner's convenience. No claims are amended.

The Rejections Under 35 USC § 102(b) Are Traversed

All claims 1-24 were rejected under 35 USC § 102(b) as anticipated by Ashby EP 0809969. The rejections of the claims are traversed.

The rejections are based on the premise that Ashby discloses a device as claimed, and particularly one including (a) a cutting jig; (b) having U-shaped projections with slots; (c) wherein the drilling jig can be placed onto the mounts of the base body via the cutting jig. The applicants dispute that Ashby makes these alleged disclosures, and any necessary related elements of the claims. The elements will be addressed individually below.

Ashby does not disclose a ligament-tensioning device adapted for placement of a cutting jig onto mounts of the base body of the device, as claimed. Element 27 of Ashby, cited in the official action as a cutting jig, is in fact a drill guide block. See page 4, column 5, lines 51 to 52.

The cutting guides of Ashby are designated by reference elements 60, 71, and 90. See, for example, column 7, line 44, column 9, lines 33-34, column 10, lines 26-27, and associated Figures 8, 9, and 17-19.

The cutting guides of Ashby are not mounted onto the body of the tensioning device, but instead are used independently. The cutting guides are placed onto drill pins (e.g. elements 54, Fig. 9) which are previously placed in the bone in a separate operation using the tensioning device and drill guide of Ashby (see Fig. 6).

The tensioning device of Ashby is removed prior to use of the separate cutting jig (e.g. 60, Fig. 9) of Ashby. See column 7, lines 30-56, particularly lines 30-32, 36-40, and 53-56. Ashby does not disclose mounting a cutting jig on the tensioning device, but rather discloses using the cutting jig independently, mounted on pins placed into the bone.

The official action states that the drilling jig can be placed onto the mounts of the base body via the cutting jig, citing page 5, column 1 [sic, column 7], line 50, to column 2 [sic, column 8], line 1. The citation does not support this assertion. As described above, the description in column 7 clearly indicates that the drilling jig is an

integral part of the tensioning device, and the cutting jig is a separate structure that is used independently.

It is fundamental that to anticipate a claim, the prior art reference must disclose all elements of the claim. Ashby does not disclose a ligament-tensioning device as claimed which is adapted for placement of a cutting jig onto mounts of the base body of the device. Thus, the claims are in compliance with § 102(b) and for the foregoing reason alone the anticipation rejections should be withdrawn.

Various of the dependent claims further distinguish the claimed apparatus and method from the cited reference.

For example, claim 2 recites a refinement wherein the jig has U-shaped projections with slots. No cutting jig of Ashby (60, 71, or 90) has such a structure. The drill guides 27 cited in the action also do not have such a structure. Instead, the guides 27 are block-shaped, without projections, and element 31 is an indentation – not a slot.

As another example, claim 4 recites a refinement wherein the cutting jig can be fixed to the mounts by means of a locking element. No device or cutting jig of Ashby has such a cooperating structure. Instead, the friction locking means of Ashby is a combination of a fine rack on each inner side of the shafts 24 attached to the drill guide blocks 27 which are engaged by a “resilient element” located within the guide member 23. See column 5, line 56, to column 6, line 5, and Fig. 3. The cutting jigs (60, 71, and 90) have no such cooperating structures. Indeed, the tie members 26 (see Fig. 3) prevent removal of the drill guides 27.

With the foregoing understanding, it becomes clear that dependent claims 3, 5, 6, 7, etc., are also distinct from the structure of Ashby.

For the foregoing reasons, withdrawal of the rejections and allowance of all pending claims are requested.

Incomplete Action

The official action has not addressed all of the claims, and thus is incomplete. See MPEP 2106:

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the

application, even if one or more claims are found to be deficient with respect to some statutory requirement.

It is respectfully submitted that the official action is incomplete in part, no reasons for rejection having been given for some specific claims, but rather a blanket rejection was provided for all claims. For an official action to be complete, an explanation must be provided as to why each claim, including each of the dependent claims, is allegedly anticipated.

The patent statute requires that the reason must be provided for a rejection of a claim. See 35 USC § 132(a): “Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application.”

The requirements for thoroughness of an action are described in Rule 104 under 37 CFR: “[t]he examination shall be complete with respect to both to compliance of the application or patent under reexamination with the applicable statutes, rules, and other requirements, and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated. . . . The reasons for any adverse action or any objection or requirement will be stated and such information or references will be given as may be useful in aiding the applicant . . . to judge the propriety of continuing the prosecution.” See also MPEP § 707 Completeness and Clarity of Examiner’s Action.

For example, claims 20-24 were not examined and rejected with the specificity required by the rules, but rather a conclusory statement was made. No showing was made as to how the Ashby reference discloses all elements of the claims. The burden is on the U.S. Patent and Trademark Office in the first instance to provide reasons for rejection.

It is respectfully suggested that if the rejections of the claims are maintained, then the reasons for the rejection of each claim should be provided with the subsequent written Office action, and the action cannot be made final.

CONCLUSION

In view of the foregoing, entry of the amendments to the claims, withdrawal of the rejections, and allowance of all pending claims are respectfully requested.

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, the examiner is urged to telephone the undersigned attorney at the indicated number

Respectfully submitted,

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